

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kil-soo JUNG et al.

Application No. 10/612,415

Group Art Unit: 2175

Confirmation No. 3598

Filed: July 3, 2003

Examiner: William L. Bashore

For: METHOD TO DISPLAY A MARK-UP DOCUMENT ACCORDING TO A PARENTAL LEVEL, METHOD AND APPARATUS TO REPRODUCE THE MARK-UP DOCUMENT IN AN INTERACTIVE MODE, AND A DATA STORAGE MEDIUM THEREFOR

RESPONSE TO REQUIREMENT FOR ELECTION OF SPECIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action mailed May 30, 2008, and having a period for response set to expire on June 30, 2008.

Errors in the Office Action of May 30, 2008

Claims 1-4, 6-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52-58 are pending, with claims 1, 6, 7, 9, 15, 17, 20, 22, 25, 34, 50, and 52 being independent. Claims 1-4, 6-14, 17-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52 are under consideration as being directed to elected Invention I. New claims 53-58 added in the Amendment of November 6, 2007, are directed to elected Invention I. Claims 15 and 16 are withdrawn from consideration as being directed to non-elected Invention II.

In item 4 on page 1 (the Office Action summary) of the Office Action of May 30, 2008, the Examiner states that "[c]laim(s) 1-4, 6-20, 22, 25-27, 34, 35, 37-45, 47-50 and 52-~~56~~ are pending in the application." However, claims 1-4, 6-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52-~~58~~ are actually pending in the application.

In item 8 on page 1 (the Office Action summary) of the Office Action of May 30, 2008, the Examiner states that "[c]laims subject to restriction and/or election requirement are 1-4, 6-14, 17-20, 22, 25-27, 34, 35, 37-45, 47-50 and 52-56." However, it is submitted that the claims that are subject to the requirement for an election of species set forth in the Office Action of May 30 are actually claims 1-4, 6-14, 17-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52-58.

Provisional Election of Species

The Examiner has required the applicants to elect one of the following patentably distinct species of the invention:

- I. Claims 10, 35, 37-45, 49, and 55-58 (listed by the Examiner as claims 10, 55-56, 57-58, 35, 37-45, 49)
- II. Claims 11-13, 26, 27, 47, 48, 53, and 54 (listed by the Examiner as claims 11-13, 53-54, 26-27, 47-48)

The Examiner considers claims 1-4, 6-9, 17-20, 22, 25, 34, 50, and 52 to be generic.

However, the Examiner did not mention claim 14, which is under consideration as being directed to elected invention I, in setting forth the requirement for an election of species. Accordingly, it is submitted that claim 14 must be examined regardless of which species is elected.

Pursuant to 37 CFR 1.143 and 1.146, the applicants elect with traverse Species 1 (claims 10, 35, 37-45, 49, and 55-58) in response to the initial requirement for an election of species set forth in the Office Action of May 30, 2008.

Accordingly, it is respectfully requested that claims 10, 35, 37-45, 49, and 55-58 of Species I, generic claims 1-4, 6-9, 17-20, 22, 25, 34, 50, and 52, and claim 14 that was not mentioned by the Examiner be reconsidered in light of the arguments presented in the Amendment of November 6, 2007.

The Requirement for an Election of Species Is Traversed

Pursuant to 37 CFR 1.143, the requirement for an election of species is respectfully traversed, and reconsideration and withdrawal of the requirement for an election of species is respectfully requested.

The Examiner states as follows on page 2 of the Office Action of May 30, 2008:

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

However, it is submitted that the Examiner's use of the phrase "and/or" in explaining why there is allegedly an examination and search burden is improper because this makes it impossible to determine what the Examiner's reasons actually are. Either the species require a different field of search, or they don't. Either the prior art applicable to one species would not likely be applicable to another species, or it would. Either the species are likely to raise different non-prior art issues under 35 U.S.C. 101, or under 35 U.S.C. 112, first paragraph, or under both 35 USC 101 and 112, first paragraph, or they aren't. Accordingly, it is respectfully requested that the Examiner provide a definite statement of what his reasons actually are should he repeat the requirement for an election of species.

Furthermore, it is submitted that it is impossible for the Examiner to show that there is an examination and search burden with respect to claims 1-4, 6-14, 17-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52 because the Examiner has already searched and examined all of these claims three times, i.e., in the Office Action of April 5, 2006; the Final Office Action of October 19, 2006; and the Office Action of August 6, 2007. In light of this, it is submitted that the Examiner is required to continue to search and examine claims 1-4, 6-14, 17-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52 to avoid wasting the resources of the U.S. Patent and Trademark Office that were expended in preparing the Office Action of April 5, 2006; the Final Office Action of October 19, 2006; and the Office Action of August 6, 2007, and the resources of the applicants that were expended in preparing the Amendment of August 3, 2006; the Amendment After Final of January 19, 2007; and the Amendment of November 6, 2007, responding thereto.

For at least the foregoing reasons, it is submitted that the requirement for an election of species is improper, and it is respectfully requested that the requirement for an election of species be withdrawn, and that all of claims 1-4, 6-14, 17-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52 continue to be considered on the merits, and that new claims 53-58 added in the Amendment of November 6, 2007, and directed to elected Invention I be considered on the merits.

Rejoinder

Since claims 11-13, 26, 27, 47, 48, 53, and 54 of non-elected Species II depend from generic claims 9, 22, 25, and 34, and since generic claims 9, 22, 25, and 34 are considered to be allowable at least for the reasons discussed in the Amendment of November 6, 2007, it is submitted that the applicants are entitled to rejoinder of non-elected Species II pursuant to 37 CFR 1.141(a) MPEP 821.04 and 821.04(a).

For at least the foregoing reasons, it is respectfully requested that the requirement for an election of species be withdrawn, and that claims 11-13, 26, 27, 47, 48, 53, and 54 of non-elected Species II be considered on the merits.

Conclusion

In view of the arguments set forth above and in the Amendment of November 6, 2007, it is submitted that claims 1-4, 6-20, 22, 25-27, 34, 35, 37-45, 47-50, and 52-58 are allowable, and an indication to that effect is respectfully requested.

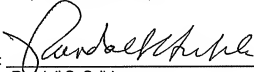
Should any questions remain unresolved, the Examiner is requested to telephone the undersigned attorney.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 07/01/08

By: 
Randall S. Svihla
Registration No. 56,273

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510